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66/945 7590 07/09/2009 TOWNSEND AND TOWNSEND CREW LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111				
EXAMINER				
RETTA, YIHDEGA				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/676,723

Applicant(s)

NGUYEN ET AL.

Examiner

Yehdega Retta

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-11, 13, 14, 17-24, 27, 28, 30-34, 39-50 and 52-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-11, 13, 14, 17-24, 27, 28, 30-34, 39-50 and 52-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to amendment filed March 18, 2009. Applicant amended claims 1, 6, 7, 9, 14, 24, 28, 30, 33, 35, 39 and 46, canceled claims 2, 3, 12, 15, 16, 25, 26, 29, 35-38 and 51. Claims 63-72 also have been added. Claims 1, 4-11, 13, 14, 17-24, 27, 28, 30-34, 39-50 and 52-72 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-10, 13, 14, 17-24, 27, 28, 30-34, 39-50 and 52-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Iannacci (US 2002/0062249).

Regarding claims 1 and 4, Iannacci teaches using a portable device to conduct the transaction, the portable device having portable device information (see fig. 4); determining if a terms and conditions statement is needed for the transaction based on the portable device information; dynamically generating the terms and conditions statement for the transaction; and outputting the generated terms and conditions statement; using the portable device information to dynamically generate the terms and conditions statement (see [0243]-[0244], [0256]-[0258]); wherein the information related to the portable device comprises information indicating whether the terms and conditions statement has been accepted before wherein dynamically generating the terms and conditions statement comprises using the portable device information to dynamically generate the terms and conditions statement, and wherein the information related to the portable

device comprises information indicating whether the terms and conditions statement has been accepted before (see [0237]-[0239]); determining information related to a device outputting the generated terms and conditions statement (see (see fig. 14-18, [0243], [0397]);

Regarding claim 5, Iannacci teaches wherein the information related to the device comprises information indicating whether the device is capable of displaying or printing the terms and conditions statement, wherein the terms and conditions statement is dynamically generated for a display format or a printed format based on the information related to the device; and wherein outputting the terms and conditions statement comprises displaying the terms and conditions statement in the displayed format or printed format (see [0243]).

Regarding claims 6-8, Iannacci teaches receiving input indicating whether the terms and conditions statement is accepted; if the terms and conditions statement has been accepted, processing the transaction using the portable device based on a first set of rules; and if the terms and conditions statement has not been accepted, processing the transaction using the portable device based on a second set of rules; determining if redemption of an item is possible etc., (see fig. 4, 6, 8, [0197], [0397]-[0399]).

Regarding claims 9, 10, and 13, Iannacci teaches obtaining parameters for a loyalty program; determining T&C information for the loyalty program from the parameters; sending the T&C information to a distribution channel, wherein the T&C information enables the distribution channel to dynamically generate T&C statements for one or more portable devices for corresponding loyalty transactions; wherein the T&C information comprises a plurality of tags; [0197], [0397]-[0399], fig. 4, 6, 14, 16); *determining a plurality of parameters for the*

T&C information, wherein the plurality of parameters (account number, account owner's name type of award etc.,) are used to dynamically generate the terms and conditions statements with the T&C information (see fig. 13, 14, 16).

Regarding claims 14, 17-23, Iannacci teaches an information determiner configured to determine information specific to a loyalty transaction; logic to dynamically generate a T&C statement based on the determined information for the loyalty transaction; and an output to output the generated T&C statement; wherein the information specific to the loyalty transaction comprises a T&C file that includes information useable to generate the T&C statement; *wherein the information specific to the loyalty transaction comprises a T&C file that includes information useable to generate the T&C statement, wherein the information specific to the loyalty transaction comprises a parameter file that includes information useable to generate the T&C statement (account number, account owner's name type of award etc.,) (see fig. 13, 14, 16);* wherein the T&C file includes tags that correspond to parameters in the parameter file, the corresponding parameters being used to generate the T&C statement; wherein the information specific to the loyalty transaction includes information retrieved from a portable device; wherein the information retrieved from the portable device includes user information and information relating to a loyalty program; wherein the T&C statement is generated based on characteristics of the device (see fig. 4, 6, 8, 10, 12B, and associated paragraphs).

Regarding claim 24 and 27, Iannacci teaches a plurality of T&C files and a plurality of parameter files useable to generate T&C statements; control logic configured to select a T&C file from the plurality of T&C files and a parameter file from the plurality of parameter files for a loyalty transaction; and control logic configured to dynamically generate a T&C statement for

the transaction using the selected T&C file and the selected parameter file; *wherein the control logic selects the T&C file and the parameter file using information specific to the loyalty transaction; wherein the information specific to the loyalty transaction comprises at least one of portable device information for a portable device, information related to how the device can output the T&C statement, information that indicates if the T&C statement has been accepted before, and information that indicates if redemption is possible for the loyalty transaction (see [0243],[0523], [0533]-[0538], fig. 14, 18,); further comprising control logic configured to communicate with the portable device to save information on the portable device regarding whether the T&C statement has been accepted by a user of the portable device (see [0045]-[0049]).*

Regarding claims 28 and 30, Iannacci teaches a method for generating terms and conditions (T&C) statements for a plurality of portable devices, the method comprising: determining if a T&C statement is needed for a loyalty transaction; determining that the T&C statement is needed, and determining information specific to the loyalty transaction (see [0399]-[0401]); generating the T&C statement dynamically using the information specific to the loyalty transaction; and outputting the generated T&C statement; *wherein determining information specific to the loyalty transaction comprises: determining portable device information specific to a portable device; and wherein generating the T&C statement comprises using the portable device information to dynamically generate the T&C statement (see fig. 4, 6, 8, [0197], [0397]-[0399]) the information indicating whether the T&C statement has been previously accepted, (see [0009]-[0013], [0021],[0025][0028][0034]-[0036], see also fig. 8, 10, 13-18),*

Regarding claims 31 and 32, Iannacci teaches dynamically generating for a display format or a printed format based on the information related to the device; and wherein outputting the terms and conditions statement comprises displaying the terms and conditions statement in the displayed format or printed format (see [0243], [0397], 3fig. 4, 6).

Regarding claims 33 and 34, Iannacci teaches receiving input indicating whether the terms and conditions statement is accepted; if the terms and conditions statement has been accepted, processing the transaction using the portable device based on a first set of rules; and if the terms and conditions statement has not been accepted, processing the transaction using the portable device based on a second set of rules; determining if redemption of an item is possible etc., (see fig. 4, 6, 8, [0197], [0397]-[0399]).

Regarding claim 39, 40, Iannacci teaches using a portable devices to conduct a transaction (see [0397]); determining portable device information specific to the portable device [0398]; determining a loyalty program applicable to the transaction (see [0399]-[0401]); determining terms and conditions information related to the loyalty program usable for generating a T&C statement for the transaction; generating the T&C statement using the information; outputting the generated T&C statement; receiving an indication indicating whether the T&C statement was accepted or rejected by a user of the portable device; and processing the transaction based on acceptance or rejection by the user, *wherein generating the T&C statement using the T&C information comprises modifying prior T&C information with parameters which are specific to the transaction and the portable device information*; processing the transaction as loyalty transaction if the T&C is accepted (see fig. 4, 6, 8, [0197], [0397]-[0399]).

Regarding claims 41-45, Iannacci teaches determining an incentive to apply to the loyalty transaction; and applying the incentive to the loyalty transaction; communicating with the portable device to save information on the portable device indicating that the incentive was awarded; determining an accumulation value based on purchase of an item for the loyalty transaction; and communicating with the portable device to save the accumulation value on the portable device; wherein processing the transaction comprises processing the transaction as a non-loyalty transaction if the T&C statement is rejected by the user; communicating with the portable device to store information that indicates whether the T&C statement has been accepted or rejected (see [0189]-[0197], fig. 13-16).

Regarding claims 46-50, 52-62, Iannacci teaches one or more portable devices; a plurality of distribution channels, each distribution channel comprising: an information determiner configured to interact with a portable device to determine information specific to a loyalty transaction; logic to generate a T&C statement for the loyalty transaction based on the determined information; and an output to output the generated T&C statement; wherein the information specific to the loyalty transaction comprises portable device information specific to the portable device; wherein the information specific to the loyalty transaction comprises at least one of information related to the output, information indicating if the T&C statement has been accepted before, and information indicating if redemption is possible for the loyalty transaction; further comprising a host, the host configured to communicate with the plurality of distribution channels and transmit information used to determine how to generate the T&C statement(see fig. 4, 6, 8, 10, 12B, and associated paragraphs); *wherein the distribution channel determines whether to generate the T&C statement based on at least one of a plurality of criteria including*

whether the T&C statement is needed for the transaction, whether the T&C statement has been previously accepted, whether the T&C statement has been revised since it was last accepted and whether acceptance of the T&C statement needs to be obtained again (see [0009]-[0013], [0021],[0025][0028][0034]-[0036], see also fig. 8, 10, 13-18),

Regarding claims 63 and 64, Iannacci teaches determining that a prior terms and conditions statement has been previously accepted, and requires revision and reacceptance for the transaction to process, and generate the terms and condition statement by using the portable device information to modify the prior terms and conditions using parameters which are specific to the transaction to generate the terms and conditions statement; determining that a prior terms and conditions statement has been previously accepted, and does not require revision and reacceptance for the transaction to process (see [0009]-[0013], [0021],[0025][0028][0034]-[0036], see also fig. 8, 10, 13-18).

Regarding claims 65 and 66, Iannacci teaches logic to determine that a prior T&C statement has been previously accepted, determine that the prior T&C statement requires revision and reacceptance for the loyalty transaction to process, and logic to generate the T&C statement for the loyalty transaction using the parameter file to modify the prior T&C file; logic to determine that a prior T&C statement has been previously accepted, and logic to determine that the prior T&C statement does not require revision and reacceptance for the loyalty transaction to process (see fig. 4, 6, 8, [0197], [0397]-[0399]).

Regarding claims 67-72, Iannacci teaches control logic to determine that a prior T&C statement has been previously accepted, determine that the T&C statement requires revision and reacceptance for a reward redemption to process, and control logic to generate the T&C

statement for the reward redemption using the parameter file to modify the prior T&C statement control logic to determine that a prior T&C statement has been previously accepted; and control logic to determine that the prior T&C statement does not require revision and reacceptance for a reward redemption to process (*see* [0009]-[0013], [0021],[0025][0028][0034]-[0036], *see also* *fig. 8, 10, 13-18*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iannacci as applied to claim 9 above, and further in view of Thurlow et al. (US 5,917,489).

Regarding claim 11, Iannacci does not teach wherein the plurality of tags comprises a template that is used to dynamically generate a T&C statement for at least one of the one or more portable devices. Thurlow teaches creating of rules using templates and tags. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a template to create the rules and condition of Iannacci in order to simplify the creation of the document, as taught in Thurlow (*see* col. 17 lines 35-53).

Response to Arguments

Applicant's arguments with respect to claims 1, 4-11, 13, 14, 17-24, 27, 28, 30-34, 39-50 and 52-72 have been considered but are moot in view of the new ground(s) of rejection.

Regarding Iannacci, applicant argues that Iannacci does not teach or suggest sending the T&C information to a distribution channel, wherein the T&C information enables the distribution channel to dynamically generate T&C statements for one or more portable devices for corresponding loyalty transactions. Examiner respectfully disagrees. Iannacci, (at least in [0173], [0197], [0243], [0397]-[0399], fig. 4, 6, 14, 16) teaches the advantage of the invention is that all of a user's payment and award accounts are available for immediate use regardless of physical location; the invention will provide the ability to automatically activate new payment or award account; to provide various transaction and consumer information to benefit option supplier or payment/award issuer, at the time of an action or transaction to obtain a benefit item (for example an "Instant-In" account enrollment system and process). Iannacci also teaches that the consumer may input and be presented with transaction data and optional data input requesting using portable and ultra mobile electronic devices that allow entry, notification and interaction during a transaction by means of messaging (see [0190],[0244]-[0248], [0254], [0275], [0288]).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Spaeth et al. (US 2004/0054591) teaches changing a participation status in a loyalty program for a portable device.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622